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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,567	05/26/2005	Ulrich Sander	33997.0115	2192
26712	7590	05/11/2007		
HODGSON RUSS LLP THE GUARANTY BUILDING 140 PEARL STREET SUITE 100 BUFFALO, NY 14202-4040			EXAMINER CONSILVIO, MARK J	
			ART UNIT 2872	PAPER NUMBER
			MAIL DATE 05/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/536,567	SANDER, ULRICH	
	Examiner	Art Unit	
	Mark Consilvio	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/29/2005 and 10/21/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/21/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement filed 08/29/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

Claims 15-17 are objected to because of the following informalities:

Claims 15-17 depend from cancelled claim 1. For the purposes of examination the claims have been read as if they depend from claim 14.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 19, 20, 22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Hermann et al. (US Patent Application Publication No. 2004/0105147).

With respect to claim 14, Hermann discloses an apparatus comprising: a main microscope including a main objective (7) having an optical axis (9), a pair of main stereoscopic observation beam paths passing through the main objective (7), and a zoom (37) in the main observation beam paths, the zoom (37) having an axis arranged at an angle to the optical axis (9) of the main objective (7); an assistant's microscope; and a beam splitter (17) arranged in the main observation beam paths between the main objective (7) and the zoom (37) for reflecting out a pair of assistant's stereoscopic observation beam paths to the assistant's microscope; wherein the beam splitter (17) is continuously rotatable, together with the assistant's microscope, relative to main microscope about the optical axis (9) of the main objective (7), whereby the beam splitter (17) and assistant's microscope are optically usable in any rotational position (fig. 1).

With respect to claim 15, Hermann discloses the zoom (37) includes an optical system (39, 40) in each of the pair of main stereoscopic observation beam paths (fig. 1).

With respect to claim 16, Hermann discloses the axis of the zoom (37) extends substantially perpendicular to the optical axis (9) of the main objective (7) (fig. 1).

With respect to claim 19, Hermann discloses the assistant's microscope includes a deflection element (42 i.e. closest to 31) for receiving the pair of assistant's stereoscopic observation beam paths along an assistant's microscope axis and redirecting the pair of assistant's stereoscopic observation beam paths into an assistant's binocular tube (21) (fig. 1).

With respect to claim 20, Hermann discloses the assistant's microscope further includes optical components (42 i.e. closest to 17) in the assistant's microscope axis between the beam splitter (17) and the deflection element (42 i.e. closest to 31), the optical components providing an image rotation between the beam splitter (17) and the deflection element (fig. 1).

With respect to claim 22, Hermann discloses the rotation of the beam splitter (17) together with the assistant's microscope is drivable in motorized or manual fashion.

With respect to claim 24, Hermann discloses the main objective (7) has a fixed focal length (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US Patent Application Publication No. 2001/0010592) in view of Biber (US Patent No. 5,898,518).

With respect to claim 14, Nakamura discloses an apparatus comprising: a main microscope (1) including a main objective (21) having an optical axis (K1), a pair of main stereoscopic observation beam paths passing through the main objective (21), and a zoom (22) in the main observation beam paths, the zoom having an axis arranged at an angle to the optical axis (K1) of the main objective (21); an assistant's microscope (26); and a beam splitter (B1) arranged in the main observation beam paths before the main objective (21) and the zoom (22) for reflecting out a pair of assistant's stereoscopic observation beam paths to the assistant's microscope; wherein the beam splitter (B1) is continuously rotatable, together with the assistant's microscope (26), relative to main microscope (1) about the optical axis (K1) of the main objective (21), whereby the beam splitter (B1) and assistant's microscope (26) are optically usable in any rotational position (figs. 1-5). Nakamura does not expressly disclose the beam splitter arranged between the main objective and the zoom. However, Biber discloses a similar stereomicroscope with an assistant's microscope (37) attached wherein the assistant's microscope (37) is disposed between the main microscope (38) (including a zoom system) and the main objective (30) (fig. 3a) and teaches that the desirability of this arrangement so that an assistant can adjust the illumination system for the main observer and vice versa (col. 1, lines 51-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to arrange the beam splitter of Nakamura between the main objective and zoom system for the advantages taught by Biber (col. 1, lines 51-65) and/or to reduce the number of parts (i.e. multiple objectives) as would have been understood by one of ordinary skill.

With respect to claim 15, Nakamura discloses the zoom (22) includes an optical system in each of the pair of main stereoscopic observation beam paths (fig. 3).

With respect to claim 16, Nakamura discloses the axis of the zoom (22) extends substantially perpendicular to the optical axis (K1) of the main objective (21) (par. 44).

With respect to claim 17, Nakamura discloses the assistant's microscope (26) is mechanically detachable from the main microscope (1) (par. 15).

With respect to claim 18, Nakamura discloses the beam splitter (B1) is mechanically detachable from the main microscope (1) together with the assistant's microscope (26) (fig. 2).

With respect to claim 19, Nakamura discloses the assistant's microscope (26) includes a deflection element (27) for receiving the pair of assistant's stereoscopic observation beam paths along an assistant's microscope axis (K4) and redirecting the pair of assistant's stereoscopic observation beam paths into an assistant's binocular tube (19) (fig. 2).

With respect to claim 20, Nakamura discloses the assistant's microscope (26) further includes optical components in the assistant's microscope axis (K4) between the beam splitter (B1) and the deflection element (27), the optical components (IR) providing an image rotation between the beam splitter and the deflection element (figs. 5-7).

With respect to claim 21, Nakamura discloses the deflection element (27) is rotatable relative to the beam splitter (B1) about the assistant's microscope axis (K4) (par. 41).

With respect to claim 22, Nakamura suggests the rotation of the beam splitter (B1) together with the assistant's microscope (26) is drivable in motorized or manual fashion.

With respect to claim 23, Nakamura discloses deflection element (27) is rotatable relative to the beam splitter (B1) to vary a tilt angle between the assistant's microscope axis (K4) and the direction of the pair of assistant's stereoscopic observation beam paths after redirection by the deflection element (27) (fig. 5).

With respect to claim 24, Nakamura suggest the main objective (21) has a fixed focal length (i.e. when the lenses L2 are not moved).

With respect to claim 25, Nakamura suggests the main objective (21) has a variable focal length (par. 32).

With respect to claim 26, Nakamura does not expressly an illumination beam path directed through the main objective. However, it is well known in the art that illumination beams may be directed through the main objective of a microscope. For example, Biber teaches such an arrangement (figs. 1a-3b). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide an illumination beam path directed through the main objective as an alternative to the arrangement of Nakamura so that the objective lenses may be used to focus the illumination beam on the subject thereby eliminating the need for additional focusing lenses.

With respect to claim 27, Nakamura discloses the main objective (21) is divided into at least two parts (par. 32).

With respect to claim 28, the combination of Nakamura and Biber suggests one part of the main objective is used for the main observation beam paths of the main microscope, and another part of the main objective is used for the illumination beam path (i.e. Biber figs. 1a-3b).

With respect to claim 29, Nakamura does not expressly disclose the main objective is rotatable, together with the illumination beam path, about the optical axis of the main objective. However, Biber teaches such an arrangement may be desirable (col. 4, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the main objective to be rotatable, together with the illumination beam path, about the optical

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axis of the main objective so that the illumination system can be incorporated into the main body housing the objective.

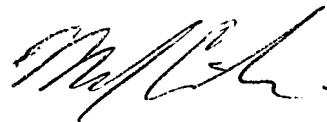
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose features similar to those claimed or disclosed by the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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